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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221325
Party	Plaintiff Red Bull GmbH
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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being filed electronically with the Trademark Trial and Appeal Board via ESTTA, on the date below:

January 11, 2016 /Angelique M. Riordan/
Angelique M. Riordan

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

	)	**Consolidated Proceeding No. 91-221,325**
RED BULL GMBH,	)	Opposition No.: 91-221,325
	)	Serial No.: 86/324,277
Opposer/Petitioner	)	Trademark: 
	)	
v.	)	
	)	
JORDI NOGUES[1]/JORDI NOGUES, S.L.,	)	Cancellation No.: 92-061,202
	)	Registration No.: 4,471,520
	)	Trademark: 
Applicant/Registrant	)	
	)	

OPPOSER/PETITIONER'S OPPOSITION TO APPLICANT/REGISTRANT'S MOTION TO RECONSIDER AMENDED SUSPENSION ORDER

Opposer/Petitioner, Red Bull GmbH ("Red Bull"), hereby opposes Applicant/Registrant, Jordi Nogues/Jordi Nogues, S.L.'s ("Jordi"), Motion to Reconsider Amended Suspension Order ("Motion to Reconsider"). It is uncontested that on December 11, 2015, the Trademark Trial and Appeal Board ("Board") held a telephonic hearing at the request of Red Bull and that on December 14, 2015, the Board issued a Board Order, amending its previous Board Order. The rest of the facts alleged by Jordi are shockingly false/misleading,[2] and exhibit a lack of understanding of TTAB practice.[3] The telephone hearing conducted by the Board on December 11, 2015 was strictly limited to procedural matters, exactly as the Board told Jordi it would be prior to the conference. Based on Trademark Rule 2.127(d), proceedings were suspended pending Red Bull's Motion for Judgment on the Pleadings as to all matters not germane to this motion, including discovery, as correctly stated in

[1] Improperly amended to Jordi Nogues, S.L.
[2] See discussions, *infra*.
[3] As discussed *infra* Jordi's failure to follow TTAB practice, combined with his misleading statements, successfully confused the paralegal who initially prepared the suspension order (and which was corrected in the order under review).

the Board's December 14, 2015 order. It is, thus, unnecessary for the Board's December 14, 2015 order to be amended.

I. Jordi's Motion for Reconsideration Simply Rehashes Its Previously Made Arguments.

Even a cursory review of Jordi's motion for reconsideration makes it clear that it is simply a rehash of previously made arguments. Since the issues have already been duly considered and ruled on, reconsideration should not be granted based upon these rehashed arguments. While Red Bull believes the reconsideration motion should be denied on this basis alone, we address the merits of Jordi's motion herein for completeness.

II. Jordi Failed to Follow TTAB Practice and Protocol By Filing Multiple Papers During a Suspension Period Which Successfully, Although Improperly, Confused the Board's Staff.

When a Motion for Judgment on the Pleadings (a potentially dispositive motion) is filed, as Red Bull did on November 12, 2015, TTAB practice dictates that all proceedings shall be suspended. The suspension process is a manual process and suspension orders, typically prepared by paralegals, issue several days after the filing of a potentially dispositive motion. Except under highly unusual circumstances, the suspension order will be retroactive to the date the potentially dispositive motion was filed. Indeed the facts in *Leeds Technologies Limited v. Topaz Communications Ltd.* ("*Leeds*"),[4] almost exactly match the facts in the instant proceeding. In *Leeds*, the plaintiff filed a motion for judgment on the pleadings and a motion to suspend proceedings pending that motion.[5] After the plaintiff filed its motion for judgment on the pleadings, and before the Board issued a suspension order, the plaintiff's deadline to serve discovery requests passed. The defendant tried to argue that the plaintiff's failure to serve its discovery responses after the filing of its motion for judgment on the pleadings was an act of bad faith and claimed that the plaintiff "unilaterally decided not to

[4] 65 U.S.P.Q. 2d 1303 (TTAB 2002). Notably, one of the Judges on this published opinion is the current Chief Judge, Gerard Rogers.

[5] Red Bull fully complied with the recommendations of the Board in that Red Bull timely and expressly alternatively sought an extension of time to respond to the outstanding discovery if the stay was not granted. Indeed, that contingent motion – which is mooted by the Board's current ruling – would again be up for review and decision if the Board were to revise its December 14, 2015 order.

answer the outstanding discovery requests."[6] The Board held that "since the parties are presumed to know that the filing of a potentially dispositive motion will result in a suspension order, the filing of such a motion generally will provide parties with good cause to cease or defer activities unrelated to the briefing of such motion."[7] The Board considered the suspension of proceedings in *Leeds* to be retroactive as to the filing of the plaintiff's potentially dispositive motion.

Notwithstanding Jordi's presumed knowledge that all proceedings would be suspended retroactive to the date of filing the motion for judgment on the pleadings, eight (8) days later Jordi filed a Motion to Compel.[8] This motion was out of order as suspension of the case, as Jordi knew under the *Leeds* practice, would be retroactive to the date of filing of the Motion for Judgment on the Pleadings. The Board confirmed this policy on December 1, 2015 in footnote 2 of its Board Order, stating:

> Inasmuch as the proceeding was considered suspended as of the filing date of Petitioner's motion for judgment on the pleadings, Respondent's motion to compel will be given no consideration. If judgment is not entered by way of Petitioner's motion, Respondent will then have an opportunity to raise its motion to compel if it is still warranted.[9]

When a potentially dispositive motion under Trademark Rule 2.127(d) is filed, the Board issues a suspension order of *all proceedings*. Contrastingly, when a discovery motion is filed, such as a motion to compel, the Board will usually enter an order *suspending proceedings other than outstanding discovery obligations* under Trademark Rule 2.120(e).[10] Jordi's premature and improper motion to compel created confusion with the Paralegal resulting in the initial inadvertent issuance of a Rule 2.120 suspension rather than a Rule 2.127 suspension order.[11]

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[6] *See Leeds* at 1305.
[7] *Id.* at 1305-1306.
[8] *See* Motion to Compel, Docket Nos. 11 and 12 (November 20, 2015).
[9] *See* Consolidation and Suspension Order, Docket No. 13 (December 1, 2015).
[10] Indeed, when the Trademark Rules of Practice were undergoing change in 1998 as to suspension of proceedings upon filing of certain motions, there was discussion in the public record and consideration resulting in a decision not to stay outstanding discovery responses when only a discovery motion, such as a motion to compel, was filed as compared to a full suspension when a truly dispositive motion is filed, such as a motion for judgment on the pleadings.
[11] Indeed, this distinction was discussed during the telephone conference; the Interlocutory Attorney acknowledged the error, and corrected it in his subsequent order.

III. As Part of Jordi's Nefarious Motivations, He Utterly Fails to Reveal that He Is Trying to Capitalize on and Dispose of the Case Based Upon the Board Paralegal's Transitory and Now Corrected Error.

Why is Jordi making multiple, huge filings over a simple issue like a 2.120 vs. a 2.127 suspension order? Answer: Jordi is trying to "win" the case based upon the acknowledged error by the Board paralegal. First, Jordi is attempting to reinstate the erroneous order so that discovery was not stayed as of the filing date of the Motion for Judgment on the Pleadings. Second, Jordi already attempted to, and will again, attempt to have the Board *ignore* Red Bull's protective request for an extension of the discovery deadlines. If Jordi were to be successful on both, then he seeks summary judgment based upon false deemed admissions due to the pending Requests for Admissions. Effectively, Jordi is seeking to dispose of the case through these procedural shenanigans, seeking to capitalize on a transitory incorrect ruling, which is contrary to the Board's policy to decide cases on the merits.

IV. The Board's December 11, 2015 Telephone Conference Was Proper, in Accordance with Board Policy, and In No Way Violated Jordi's Right To Due Process.

The Board policy for Telephone Conferences is set forth in TBMP Section 502.06(a), which provides in relevant part (footnotes omitted; emphasis added):

> When it appears to the Board that a motion filed in an inter partes proceeding may be resolved by a telephone conference call involving the parties or their attorneys and a Board judge or attorney, the Board may, upon its own initiative or upon request made by a party, convene a conference to hear arguments on and to resolve the motion by telephone conference. Immediately after the resolution of a motion by telephone conference, the Board normally will issue a written order confirming its decision on the motion. Immediate issuance of an order may be deferred, however, if the conference raises issues that require research or additional briefing before they can be resolved.
>
> Board judges and attorneys retain discretion to decide whether a particular matter can and should be heard or disposed of by telephone. The Board may therefore deny a party's request to hear a matter by telephone conference. **There is no formal limit as to the type of matters that can be handled through telephone conferences, but the Board will not decide by telephone conference any motion which is potentially dispositive, that is, a motion which, if granted, would dispose of a Board proceeding.**

* * *

Requesting a telephone conference: A party may request a telephone conference from the assigned Board attorney before it files the underlying motion. The initial contact will be limited to a simple statement of the nature of the issues proposed to be decided by telephone conference, with no discussion of the merits. **A party served with a written motion may request a telephone conference by contacting the assigned Board attorney soon after it receives the service copy of the motion so that the responding party will have sufficient time to respond to the motion in the event the request for a telephone conference is denied.** A party may not request a telephone conference at or near the end of its time to respond to the motion when its purpose in doing so is to avoid or delay its response to the motion.

During the initial contact, the Board attorney will decide whether any party must file a motion or brief or written agenda to frame the issues for the conference and will issue instructions.

* * *

The Board may **in its discretion** require additional written briefing of the motion or decide that additional written briefing is unnecessary. The Board has the discretion to decide the motion by telephone conference prior to the expiration of the written briefing period for filing a response or reply. **If a response to a pending motion has not yet been filed, the nonmoving party should be prepared to make an oral response to the motion during the telephone conference**. Similarly, if a reply in support of a pending motion has not yet been filed, the moving party should be prepared to make its reply during the telephone conference. **Any other instructions regarding filing of briefs or serving copies will be provided at the time the Board schedules the conference.**

* * *

Participation. … Failure to participate in a scheduled telephone conference may result in the motion being denied with prejudice, the motion being treated as conceded, issuance of an order to show cause why judgment should not be entered against the non-participating party for loss of interest in the case, or the imposition of sanctions pursuant to the Board's inherent authority[12].

Issuance of Rulings. The Board attorney may make rulings at the conclusion of a telephone conference or may take the parties' arguments under advisement. In every instance, after the resolution of a motion or matter by telephone conference, the Board attorney will issue a written order containing all rulings. In most instances, the Board's written order will consist of only a brief summary of the issues and the resulting decision; generally, the order will not include a recitation of the parties' arguments. The decision will be forwarded to the parties by mail or email, and will be available for the parties to view on the Board's section of the USPTO website, specifically within the electronic proceeding file for the case (i.e., TTABVUE).

Red Bull contacted the Board by phone, in accordance with 37 C.F.R. Section 11.305 and TBMP Sections 105 and 502.06(a), to discuss purely procedural issues in the above-captioned consolidated proceeding.[13] Red Bull simply left a voicemail for the Board, requesting a telephone

[12] Since Jordi has refused to participate in a telephone conference on this motion for reconsideration, Red Bull requests that the Board exercise its discretion to deny the reconsideration motion without consideration on the merits.

[13] "Parties or their attorneys or other authorized representatives may telephone the Board to inquire about the status of a case or to ask for procedural information, but not to discuss the merits of a case or any particular issue." 37 C.F.R. Section 11.305 and TBMP Section 105.

conference with all parties involved to discuss a procedural inconsistency in a recent Board Order, the resolution of which could potentially save time for both parties and the Board and avoid unnecessary filings. Additionally, while Jordi attempts to claim that the procedural issue to be discussed was not disclosed prior to the phone call, its own exhibit contradicts this position where it shows evidence of both Red Bull and the Board providing Jordi with notice of the procedural issue to be discussed.

V. Jordi Now Attempts, Without Analysis or Authority, to ask the Board to hold TBMP Section 502.06(a) as Violative of Due Process and Unconstitutional.

Jordi alludes to some violation of its "due process" and misconduct by the Board during the December 11, 2015 telephone hearing. Jordi wholly mischaracterizes the issues discussed during the telephone conference on December 11, 2015. Not only was the phone conference strictly limited to the procedural issue in the Board's Order (and as noted in TBMP 502.06(a) the Board even has the authority to go further and address substantive issues so long as they are not case dispositive), but the telephone conference was exactly in line with the assurances provided to Jordi by the Board prior to the conference. During the conference call, Red Bull simply stated its position that, in accordance with the well-settled rules, specifically that under Trademark Rule 2.127(d), the filing of a potentially dispositive motion, here a Motion for Judgment on the pleadings, suspends proceedings as to all matters not germane to that motion, including discovery. Jordi was then given the opportunity to express its own views on this procedural issue. Suspensions under Trademark Rule 2.127 and 2.120 are routine matters handled by the Board on a daily basis, and are not some esoteric area of the law.

Surprisingly and incorrectly, Jordi claims that Red Bull's *reliance* on Trademark Rule 2.127, and TBMP Section 528.03, interpreting Rule 2.127, was "never articulated to Registrant and Registrant had no opportunity to meaningfully prepare to discuss this issue in advance of the

December 11, 2015 hearing."[14] Not only was the same rule cited in both the original Board Order and the Board's December 14, 2015 order, but Red Bull specifically noted its reliance on 37 C.F.R. Section 2.127(d) and TBMP Section 510.03(a) in its Motion for Judgment on the Pleadings, filed November 12, 2015 (long before the issuance of even the original order).[15] [16] Despite Jordi's repeated efforts to hide the truth in an attempt to support his arguments, it is clear that the Board's December 14, 2015 order correctly states the appropriate rule and reading thereof to suspend proceedings as to all matters not germane to Red Bull's outstanding Motion for Judgment on the Pleadings, including discovery.

Jordi's only authority that TBMP 502.06(a) is unconstitutional is *Benedict v. Super Bakery, Inc.*[17] This case, cited by Jordi, actually *supports* Red Bull's position and neither *Super Bakery* nor the *Transportation Leasing Co.* decision cited therein supports Jordi's position. These cases are akin to allowing a change in the Notice of Opposition or Petition for Cancellation without notice, rather than having a telephone conference to discuss and fix a procedural issue.

Jordi's "constitutional" arguments are unsupported, erroneous, and unavailing, and should be given no weight by the Board.

VI. Trademark Rule 2.127 Is The Applicable Rule In This Situation and Case Law

[14] *See* Motion to Reconsider, p. 5.
[15] *See* Motion for Judgment on the Pleadings, Docket No. 10 (November 12, 2015), p. 2.
[16] See, **Potentially dispositive motion.** When a party to a Board proceeding files a motion which is potentially dispositive of the proceeding, such as a motion to dismiss, **a motion for judgment on the pleadings**, or a motion for summary judgment, the case will be suspended by the Board with respect to all matters not germane to the motion.
[17] 665 F.3d 1263 (CAFC 2011). *Super Bakery* is cited in the TBMP and C.F.R. as a potential *exception* to the typically followed rules surrounding suspension of a proceeding pending a potentially dispositive motion. In *Super Bakery*, the defendant had repeatedly dodged his discovery obligations (for two years), including blatantly disregarding a Board Order, ordering him to provide discovery responses by a certain date. In *Super Bakery*, the court even makes the distinction that Board-ordered discovery obligations are "very different from the routine obligations arising from the service of discovery requests by an opposing party" and categorizes the defendant's actions as "a strong showing of willful evasion." Further, the court in *Super Bakery* comments on the Board's position that that the defendant's motion for summary judgment was "meritless" and simply "an effort to further obstruct petitioner's rights to obtain discovery under the Board's rules, the Board's order compelling discovery, and the Board's order granting discovery sanctions." Finally, the court affirmed the Board's position that the defendant "had continually failed to comply with Board orders, and had hampered reasonable procedures appropriate to resolution of this trademark conflict." This is clearly cited in the rules as an example of an extreme case to provide readers with an example, showing that the Board has discretion where necessary for fairness. However, it is clear this extreme case is wholly inapplicable here as Red Bull has not been dodging its discovery obligations, did not file a meritless motion, and is not in any way hindering reasonable procedures for the appropriate resolution of this case.

Supports the Board's December 14, 2015 Order, Suspending Proceedings As To All Matters Not Germane To Red Bull's Motion for Judgment On the Pleadings, Including Discovery.

Trademark Rule 2.127(d) states that

> When a party files a … motion for judgment on the pleadings … or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion.

The Board's December 14, 2015 order is correct in relying on this rule. The Board's original order cited this same rule, but instead appears to rely on Trademark Rule 2.120, which deals with discovery motions and does not necessarily suspend discovery deadlines. Here, Red Bull filed a potentially dispositive Motion for Judgment on the Pleadings, which is much different from a discovery motion, for which Trademark Rule 2.120 would be applicable. During the December 11, 2015 telephonic hearing, the difference between these two procedural rules was discussed and nothing regarding the merits of any prior-filed motions was discussed. The Board simply noted that Red Bull had filed a Motion for Judgment on the Pleadings, which, by its very nature, is a potentially dispositive motion. A motion for judgment on the pleadings is not a discovery motion. Based on this distinction, procedurally, Trademark Rule 2.127 applies (not Trademark Rule 2.120) and, as such, the Board issued its December 14, 2015 order, suspending proceedings pending Red Bull's potentially dispositive motion as to all matters not germane to this pending motion, including discovery. This December 14, 2015 order is accurate and proper and should not be amended.

Despite Jordi's repeated attempts to mislead the Board about Red Bull's discovery deadline, falsely stating (again) that Red Bull requested and received "extensions of time for three (3) weeks"[18] when any and all extensions were at the request of and solely for Jordi's

[18] *See* Registrant/Applicant Jordi Nogues, S.L.'s Motion to Reconsider Amended Suspension Order ("Motion to Reconsider"), Docket No. 17 (December 22, 2015), p. 2. Jordi's conduct in continuing to make misleading assertions that Red Bull had three extensions of time to respond to discovery after Red Bull expressly pointed out – and ignored by Jordi – that it was Jordi who asked for, and was granted – three extensions to respond to discovery is highly unusual and suspect advocacy. Indeed, the continuance of Red Bull's dates was merely to maintain the same

benefit, it is clear Red Bull has not avoided its discovery obligations or in any way abused the privilege of extensions. It is clear that *Super Bakery*, the case on which Jordi relies, is wholly inapplicable here.

VII. Conclusion

Based on the above arguments, there was no misconduct on the part of the Board and no violation of Jordi's right to due process. Red Bull respectfully requests that Jordi's Motion to Reconsider be denied and that the Board's December 14, 2015 order remain the operative order. In addition, Red Bull requests that the Board enter an order requiring Jordi to comply with the Interlocutory Attorney's procedure of, jointly with Opposer's counsel, calling the Interlocutory Attorney to discuss any proposed motion before making any additional motions so as to avoid unnecessary and protracted motion practice.

Dated: January 11, 2016

Respectfully submitted,

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relative timing of discovery responses. To repeatedly argue that Red Bull was given three extensions without acknowledging these facts intentionally fails to be forthright with the Board.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER/PETITIONER'S OPPOSITION TO REGISTRANT/APPLICANT'S MOTION TO RECONSIDER AMENDED SUSPENSION ORDER** is being served on January 11, 2016, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to counsel for Registrant/Applicant at:

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